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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,276	03/07/2001	John W. Erickson	207596	9981

23460 7590 10/02/2002

LEYDIG VOIT & MAYER, LTD  
TWO PRUDENTIAL PLAZA, SUITE 4900  
180 NORTH STETSON AVENUE  
CHICAGO, IL 60601-6780

EXAMINER

FOLEY, SHANON A

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 10/02/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/720,276

Applicant(s)

ERICKSON ET AL.

Examiner

Shanon Foley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-62 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-19, drawn to an assay to determine biochemical fitness of a target to a biological mutant.

Group II, claim(s) 20-38, drawn to a method of administering a therapeutic compound.

If applicant elects groups I or II, applicant is further required to elect one predecessor from groups 1-6:

- 1) a microorganism, claims 2, 21
- 2) a virus, claims 3, 22
- 3) retrovirus, claims 4, 5, 23, 24
- 4) malarial parasite, claims 6, 7, 25, 26
- 5) bacterium, claims 8, 27
- 6) cancer cell, claims 9, 10, 28, 29

If applicant elects groups I or II, applicant is additionally required to elect one target from groups 7-9, and (a-d):

- 7) enzyme, claims 11, 16-19, 30
  - a) viral enzyme, claim 12, 31
  - b) malarial enzyme, claim 13, 32
- 8) protein, claims 15, 34
  - c) viral protein, claims 12, 31
  - d) malarial protein, claims 13, 32
- 9) oligomer, claim 14, 33

Group III, claim(s) 39, 41, 43, and 44, drawn to an assay to determine biochemical fitness of a mutant target to HIV.

Group IV, claim(s) 40, 42, and 45, drawn to a method of administering a therapeutic compound that inhibits a mutated target of HIV.

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Group V, claim(s) 46, drawn to a continuous fluorogenic assay.

Group VI, claim(s) 47-62, drawn to a method of preventing the development of drug resistance.

Group VII, claim(s) 63 and 64, drawn to a method of treating a mutant retroviral infection.

The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of group I is a first product comprising an assay to determine the biochemical fitness of a compound by comparing the inhibiting capabilities of an entity to its target. Any subsequent group that does not share the special technical feature with group I, lacks unity of invention.

Group II does not share the special technical feature with group I because the group is drawn to a first method with different method steps and ingredients.

Inventions 1-9, a-d, do not share the special technical feature of group I because each are drawn to structurally and functionally unique pathogens and organic compounds. Any single combination of predecessor and target results in identification of unrelated compounds identified in the assay of group I or administered as a therapeutic in group II.

Group III is drawn to a second product comprising an assay to determine biological fitness of a mutant target to HIV. This group does not share the special technical feature with group I because the target of group I is not mutated and the biological entity may not be a virus.

Group IV is drawn to a second method that does not share the special technical feature of group I due to separate method steps and ingredients.

Group V is drawn to a third assay to measure anti-HIV protease activity, which does not share the special technical feature of group I.

Group VI is drawn to a third method of preventing the development of drug resistance in an HIV infection, which does not share the special technical feature of group I.

Group VII is drawn to a fourth method, drawn to treating a retroviral infection, which does not share the special technical feature of the assay in group I.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the


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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanon Foley whose telephone number is (703) 308-3983. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (703) 308-4027. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4426 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
Shanon Foley  
September 30, 2002

  
JAMES HOUSEL 9/30/02  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600